

**REMARKS**

In the Office Action,<sup>1</sup> the Examiner rejected claims 1, 7, 10, 11, 14, 17, 18, 24-26, 29, 30, 33, and 36-38 under 35 U.S.C. § 103(a) as being unpatentable over JPO 05114800<sup>2</sup> to Furuyama et al. ("*Furuyama*") in view of U.S. Patent No. 6,897,737 to Sakata et al. ("*Sakata*").

Claims 1-4, 7, 10, 11, 14, 17-21, 24-26, 29, 30, 33, and 36-38 are pending, with claims 1, 7, 10, 11, 14, 17, 18, 24-26, 29, 30, 33, and 36-38 being under current examination.

Applicant respectfully traverses the rejections and requests reconsideration for at least the following reasons.

**Rejection of Claims under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 1, 7, 10, 11, 14, 17, 18, 24-26, 29, 30, 33, and 36-38 under 35 U.S.C. § 103(a) as being unpatentable over *Furuyama* in view of *Sakata*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. ... [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142,

---

<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

<sup>2</sup> The number in the Office Action is JPO 05114500. However, Applicant respectfully notes that the inventor of JPO 05114500 is not Furuyama and this publication is about a different topic. The Office Action indicates that the cited reference is "of record." Therefore, Applicant reasonably believes that the reference intended to be cited here is JPO 05114800 to Furuyama et al., which is cited in an Information Disclosure Statement filed September 16, 2006.

8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 1 calls for a combination including, for example, “a package,” “a mounting base with a second reference portion,” “a bonding material for fixing [an] oscillator ... by utilizing a self-alignment effect occurring due to surface tension,” and “wherein said second reference portion is formed by inclining at a certain angle with respect to a center line of said package” (emphases added). *Furuyama* fails to teach or suggest at least these elements.

The Office asserted that “Fig. 2 and the abstract of Furuyama disclose that the mounting occurs by self alignment due to surface tension.” Office Action, p. 2.

However, this is not correct. As taught in the abstract of *Furuyama*, “fine vibrations induced by ultrasonic waves are applied to the mounting base 11 to surely set the electronic component 13” (emphasis added). However, “[setting by] fine vibrations induced by ultrasonic waves” does not constitute any type of self-alignment, and certainly not the claimed “self-alignment ... due to surface tension” as recited in claim 1.

Moreover, the Office appears to assert that element 11 in FIGS. 1 and 2 of *Furuyama* constitutes the claimed “mounting base,” but does not point out any element in *Furuyama* which could constitute the claimed “package.” The Office then asserts that “[t]he mounting base is formed at a 90 degree inclined angle from a center line on the horizontal bottom surface of the mounting base” (amphases added). Even if this assertion were correct, which Applicant does not concede, nothing in *Furuyama* constitutes a teaching that “said second reference portion is formed by inclining at a certain angle with respect to a center line of said package” as required by claim 1.

In view of the above, *Furuyama* does not teach or suggest, at least, “a bonding material for fixing [an] oscillator ... by utilizing a self-alignment effect occurring due to surface tension” and “a second reference portion [] formed by inclining at a certain angle with respect to a center line of said package” as recited in claim 1 (emphases added).

*Sakata* fails to compensate for the deficiencies of *Furuyama*. The Office asserted that *Sakata* discloses “mounting the base (110) of a tuning-fork crystal vibrator (100) on an electrode (314) on a surface of a package (310) utilizing a conductive bonding agent.” Office Action, p. 3. Even if this assertion were correct, which Applicant

does not concede, *Sakata* also fails to teach or suggest “a bonding material for fixing [an] oscillator ... by utilizing a self-alignment effect occurring due to surface tension” and “a second reference portion [] formed by inclining at a certain angle with respect to a center line of said package” as recited in claim 1 (emphases added), and thus does not compensate for the deficiencies of *Furuyama*.

In view of the mischaracterizations of the cited references, the Office has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 1. Moreover, there is no motivation for one of ordinary skill in the art to modify the teachings of the references to achieve the claimed combinations. Thus, no reason has been clearly articulated as to why claim 1 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1.

Claim 18, although different in scope from claim 1, recites elements similar to those discussed above and recited in claim 1. Therefore, claim 18 is allowable for at least the reasons noted above in regard to the rejection of claim 1.

Claims 7, 10, 11, 14, 17, 24-26, 29, 30, 33, and 36-38 are also allowable at least by virtue of their dependence from claim 1 or 18.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 7, 10, 11, 14, 17, 18, 24-26, 29, 30, 33, and 36-38 under 35 U.S.C. § 103(a).

**CONCLUSION**

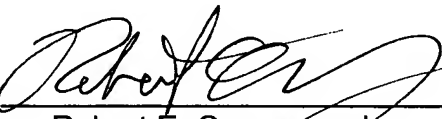
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time, not otherwise requested, which are required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 27, 2009

By:   
Robert E. Converse, Jr.  
Reg. No. 27,432  
(202) 408-4000